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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,320	04/28/2000	Michael Wayne Brown	AUS000052US1	3984

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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 05/20/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/560,320

Applicant(s)
Brown et al

Examiner
Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 10, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above, claim(s) 1-14, 27-37, 39, 40, 42, and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-26, 38, and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Apr 28, 2000 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Acknowledgments

1. The amendment filed April 10, 2003 (Paper No. 9) is acknowledged. Accordingly, claims 1-43 remain pending.

Restriction

2. This application contains claims 1-14, 27-37, 39, 40, 42, and 43 drawn to an invention nonelected without traverse in Paper No. 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
3. The Examiner again notes the Election of Species in Paper No 5 has been withdrawn. See Paper No. 7, Paragraph No. 3.

Specification

4. The disclosure is objected to because of the following informalities:
 - a. On page 14 of the originally filed specification, in the paragraph beginning with "In another example," the specification contains a reference to unidentified application.
 - b. On page 18 of the originally filed specification, in the paragraph beginning with "Absent food-related items," the specification contains a reference to unidentified application.

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c. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the “storage device carried on the person of said particular user” as recited in claim 15.

Appropriate correction is required.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following must be shown or the features canceled from the claim(s):

a. The “storage device carried on the person of said particular user” as recited in claim 15.

A proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objections to the drawings will not be held in abeyance.

Terminal Disclaimer

6. The terminal disclaimer filed April 10, 2003 (Paper No. 8) does not comply with 37 CFR 1.321(b) and/or (c). An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided

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by 37 CFR 1.34 (a). Currently, Mr. Craig Yudell is not an attorney or agent of record in this application. The Examiner acknowledges a "Change of Correspondence Address" (Paper No. 3) has been filed in this application.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

a. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

b. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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8. Claims 15 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over at least claims 11-18 of copending Application No. 09/560,317 (“‘317 Application”). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

a. Claim 11 of the ‘317 Application discloses: receiving food-related inventory preferences for each of a plurality of users (via the computer system disclosed in claim 11); adjusting a current database (adjusting future food-related orders); determining which items are absent (inherent in the “adjusting” clause in claim 11); such that the food-related inventory is managed; and claim 13 of the ‘317 Application discloses data exchange in an extensible mark-up language.

b. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112 1st Paragraph

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claim 15, 16, 18-26, 38, are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey

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to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

After careful review of the originally filed specification, it is the Examiner's position that Applicant has not disclosed "a personal electronic memory digital data storage device carried on the person of said particular user" It is also the Examiner's factual determination that because Applicant does not even mention in his originally filed specification that the data storage device is carried on the person of a particular user, Applicant has also not disclosed the claimed subject matter in an embodiment of the invention. "If the Applicant claims embodiments of the invention that are completely outside the scope of the specification, then the examiner or Board need only establish this fact to make out a prima facie case." *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996).

Based upon all the evidence of record, including but not limited to the originally filed specification, Applicant's claim amendments, his Remarks, and/or other evidence as noted above, it is the Examiner's factual determination that as of the filing date of this application, Applicant was not possession of the invention.¹

¹ "The purpose of the written description requirement is broader than to merely explain how to 'make and use'; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

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Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

12. Claims 15-25, 38, and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Sone (U.S. 6,204,763 B1). Sone discloses a store server (24 shown in figure 4) acting as an inventory processor for an automated ordering system (column 9, ~ lines 32-55) or, alternatively, personal computer (50) acting as an inventory processor for an automated ordering system; receiving (transmitting) food related inventory preferences (inherent in product desired, e.g. if user prefers milk over cream the user will specify milk and not cream) for each of a plurality of users to a controller (within 24 which is at store or at "at least one vendor") for a particular storage area (the refrigerated section 22B) that monitors current food-related inventory (e.g. milk); adjusting a current database of intended food-related inventory for the particular storage area at the controller according to the food related inventory preferences (database is changed upon refilling or having the user put the milk back in the refrigerator); determining a selection of food-related items from among the database of intended food related items that are absent from the particular storage area ("desired inventory") such that food-related inventory that is intended

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for the particular storage area (22B) is managed (inherent); a personal electronic memory digital data storage device (3.5 inch floppy drive or other removable storage device inherent in computer 50); receiving food-related inventory preferences for a plurality of users at the controller from a plurality of computer systems (e.g. 50 in figure 4); receiving food-related inventory preferences for a user from a particular storage device proffered by the particular user (e.g. 22B); the receiving is done via a universally accessible server system (the Internet) according to a particular universal identifier associated with a particular user (inherent in a user's name, address, and account number; each home user must have a unique address for delivery purposes and a unique account number for billing purposes upon automatic ordering); receiving food-related inventory preferences in an extensible mark-up language format (inherent in personal computer 50 with an Internet connection since Internet uses HTML or other XML; additional evidence of the inherency includes the modem and a display which allows the user to alter the various parameters); periodically receiving records of additions and removals of food-related items from said particular storage area (inherent, e.g. milk has a 5 day cycle); adding food-related inventory preferences to a base list of amounts (the desired inventory) of inventory in a particular storage area (when a new food-related item is added to the household inventory, column 3, ~line 52-56); adding or subtracting (adjusting and combining) food-related inventory preferences of previously received food-related inventory preferences for items to be maintained in a particular storage area (checking to see if there was an additional order "independent of the inventory processor," column 9, ~ lines 36-40 so that all orders are sent out together; or alternatively, has the item been

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removed from the order list; column 8, ~ lines 50-54); a delivery person receives a request from a particular store (for the delivery of the ordered goods); enabling access to the selection of food-related items that are absent from the particular storage area if a store is included in a plurality of allowable requesters for the particular storage area (multiple vendors with access via security controls; in other words, multiple vendors are inherent in the “at least one vendor” with authorized access, authorized access is itself inherent since some security control *must* exist because the connection is Internet based); and both the store shopping server 24 and personal computer (50) are portable (inherent since they can be moved).

13. As noted in the previous Office Action (Paper No. 7, Paragraph No. 8), it is the Examiner’s principle position that its inherent in Sone that the automatic replenishment system is used in a plurality of homes (or households).

a. Because Sone discusses prior art systems in “commercial establishments” yet not appreciated in the home environment (column 2, ~ lines 8-13), Sone inherently discloses the use of the system in a plurality of homes. Additionally evidence of the inherency is that it would be impractical for a vendor to provide the service to a single home.

b. Moreover, Sone column 2, ~ lines 33-35 states, “More particularly, the present invention comprises *a household* consumable item automatic replenishment system and method . . . [Emphasis added.]” “It is well settled that the term ‘a’ or ‘an’ ordinarily means one or more.”

Tate Access Floors Inc. v. Interface Architectural Resources Inc., 279 F.3d 1357, 1370, 61

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USPQ2d 1647, 1657 (Fed. Cir. 2002). Therefore, “a household” noted above is interpreted to mean one or more households.

14. Also as noted in the previous Office Action (Paper No. 7, Paragraph No. 9), functional recitations using the word “for” (e.g. “for managing inventory” as recited in claim 15) have been given less patentable weight because they fail to add any steps and are thereby regarded as intended use language.² A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

15. The Examiner notes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. Specifically, after receiving express notice in the previous Office Action³ of the Examiner’s position that lexicography is *not* invoked, Applicant has not pointed out the “supposed errors” in the Examiner’s position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicant has not argued lexicography *is* invoked). To further

² See also e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

³ See the Examiner’s previous Office Action mailed January 9, 2003, Paper No. 7, Paragraph No. 10.

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support the Examiner's position that Applicant is not his own lexicographer, it is the Examiner's factual determination that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements.⁴ Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation⁵ to be his own lexicographer.⁶ Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process and unless expressly noted otherwise by the Examiner, the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁷ The Examiner now

⁴ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements." *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁵ See again the Examiner's previous Office Action, Paper No. 7, Paragraph No. 10.

⁶ The Examiner's request on this matter was reasonable on at least two separate and independent grounds: first, the Examiner's request was simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed May 8, 2003).

⁷ See also MPEP §2111 and §2111.01; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en

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relies heavily and extensively on this interpretation.⁸ See e.g. *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1381, 62 USPQ2d 1865, 1877 (Fed. Cir. 2002) (“Because the patentee has not chosen to be his own lexicographer in this instance, [the claimed element] should carry its ordinary meaning”)(Clevenger, J. dissenting in part). Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

16. Under the broadest reasonable interpretation standard noted above, the Examiner maintains his interpretations. However, to the extent that the Examiner’s interpretations are either different from or in dispute with Applicant’s interpretations, the Examiner hereby adopts the following definitions as the broadest reasonable interpretation in all his claim interpretations:

a. **Adjust** “1 a: to bring to a more satisfactory state: . . . (2) : RECTIFY” Merriam-Webster’s Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

b. **Server**: “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997. **Client**: “3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a *server*).” Id. **Computer**: “Any

banc).

⁸ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

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machine that does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” Id.

c. **Personal computer** “A computer designed for use by one person at a time.” Id.

d. **Database** “A file composed of records, each containing fields together with a set of operations for searching, sorting, recombining and other functions.” Id. “: a usu. large collection of data organized esp. for rapid search and retrieval (as by a computer)” Collegiate Dictionary, supra.

e. **Device** “A generic term for a computer subsystem. Printers, serial ports, and disk drives are often referred to as devices; such subsystems frequently require their own controlling software called device drivers.” Computer Dictionary, supra.

f. **Personal** “1 : of, relating to, or affecting a person: PRIVATE INDIVIDUAL . . . 3 : relating to the person or body.” Merriam-Webster’s Collegiate Dictionary, supra.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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18. Claims 15-25, 38, and 41 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Sone.⁹ It is the Examiner's principle position that use of the automatic replenishment system in multiple homes (or households) is inherent in Sone and therefore anticipated as noted above.

Alternatively, if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Sone to include the system in multiple homes. Such a modification would have made system profitable for the vendors and delivery persons since they would never make money if the system was for a single home.

Furthermore, the placement of the automatic replenishment system in multiple homes is merely duplicating an easily delineated and expressly described embodiment in Sone. Mere duplication of parts has no patentable significance unless a new and unexpected result is produced. See MPEP §2144.04 VI *B* or *In re Harza*, 47 CCPA 771, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

19. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sone in view of Salvo et. al. (U.S. 6,341,271)("Salvo"). Sone discloses as discussed above but does not directly disclose receiving the request *from the store* for the selection of food-related items that are absent from the particular storage area. Additionally, Sone does not disclose much in terms of vendor side operations in the disclosed system.

⁹ See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

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Salvo directly teaches initiating the request by the vendor (vendor managed inventory). Salvo's vendor managed inventory system has the vendor initiating the request (column 9, ~ lines 37-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Sone as taught by Salvo and include various aspects of Salvo's vendor managed inventory system to the vendor side of Sone. In particular, this would include Salvo's vendor management tools (some of which are noted above in the cited passage). Such a modification would have further reduced delays, costs of ordering, and inventory turn around times.

Additionally, the modification would have helped synchronize inventory ordering and delivery so that food-related items are not out of stock in the home. For example, suppose milk inventory becomes low in a particular home every Saturday morning because children in the home are having cereal with milk while watching cartoons. Using the vendor's historical trend analysis tool as implemented in Salvo, automatic ordering and subsequent delivery of milk could occur every Saturday afternoon.

20. Moreover, it is the Examiner's position that all claimed features in claims 15-26, 38 and 41 are either disclosed or inherent in the references as discussed above. Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and quotations omitted)).

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Response to Arguments

21. Applicant's arguments filed with his amendment in Paper No. 9 have been fully considered but they are not persuasive.

22. Applicant argues he "respectfully disagree[s] that a refrigerator compartment can in any way show or suggest a SmartCard carried by a user."¹⁰ First and after careful review of all pending claims, the Examiner is unable locate a *single recitation* of 'SmartCard' in the pending claims. Therefore whether or not Sone discloses a SmartCard is immaterial. As Judge Clevenger has so eloquently summarized these types of arguments, "The invention disclosed in [Applicant's] written description may be outstanding in its field, but the name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

23. Even if (albeit a big if) the claim did recite "a SmartCard," such a recitation is not supported in accordance with 35 USC § 112 1st paragraph (see Paragraph No. 10 above). Additionally, it is the Examiner's position that the "carried on the person" is also new matter and in violation of 35 USC § 112 1st paragraph (see again Paragraph No. 10 above).

24. Regarding Applicant's discussion of "receiving records of additions and removals," Applicant's disagreement with the Examiner is acknowledged. Specifically, Applicant argues "Sone's system of automatic replenishment has no need to keep track of additions to the refrigerator." The Examiner respectfully disagrees. In order for the system operator to make a profit, the operator *must* keep track of items placed in the consumer's refrigerator. Thus the

¹⁰ Applicant's "Remarks," Page 9, April 10, 2003, page 9.

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billing system *must* keep track of all additions and deletions. One of ordinary skill in the art clearly recognizes that businesses do not provide products and services for free. The Examiner takes Official Notice that for-profit businesses are concerned about money and/or have a high interest in money. Since inventory usually costs money, these businesses are very concerned about, and highly interested in, inventory. Moreover, since the system is computerized, the database is adjusted. Therefore the recited claim limitations regarding “additions and removals” and the “database”, as noted in this Office Action and the previous Office Action, are inherent in Sone.

25. Regarding Applicant’s arguments involving the §103 rejection, Applicant argues, *inter alia*, nothing within Sone suggests there would be any utility for allowing a user to input their preferences using a SmartCard-type memory device within the replenishment system of Sone.”¹¹

26. First, “a SmartCard-type” memory device is not claimed. Second, whether or not there is “utility” is not relevant to an obviousness rejection. Applicant is respectfully requested to provide an authority (*i.e.* an MPEP section or a holding from a court of competent jurisdiction) which exemplifies Applicant’s requirement that the Examiner establish “utility” to make out a *prima facie* case of obviousness.

27. Regarding the rejection of claim 16 using Sone in view of Salvo, the Examiner notes that Applicant has not made any *additional* arguments pertaining to this rejection. Because Applicant has not pointed out the supposed errors in the rejection as required by 37 C.F.R. §1.111(b), the

¹¹ “Remarks” in Paper No. 9 at page 10.

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Examiner acknowledges the current allowability of claim 16 stands or falls with the allowability of claim 15.

28. The remainder of Applicant's arguments have been considered but are not persuasive.

Conclusion

29. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

30. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed.

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Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph antecedent basis and indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as described above.

31. In accordance with *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner cites How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla as additional evidence of what is basic knowledge or common sense to one of ordinary skill in the art. Each reference is cited in its entirety. The Examiner has provided Applicant with copies of selected sections including the table of contents, indexes, and/or Parts of the references.

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32. Unless expressly noted otherwise by the Examiner, the following two citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations within this Office Action are from the MPEP 8th Edition, August 2001.

33. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicant with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks" (Paper No. 9, beginning on page 8) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied¹², the Examiner respectfully requests Applicant *in his next properly filed response* to expressly traverse the Examiner's position and provide appropriate arguments and evidence in support thereof. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has *any* questions regarding the Examiner's positions or has other questions regarding this communication or even previous

¹². E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

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communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.

AJFischer 5/11/03
ANDREW J. FISCHER
PATENT EXAMINER

Michael Cuff 5/14/03
MICHAEL CUFF
PRIMARY EXAMINER

AJF
May 11, 2003